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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/591,220

10/11/2006

Birte Achten

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EXAMINER

OBEID, FAHD A

ART UNIT

PAPER NUMBER

3627

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/591,220	Applicant(s) ACHTEN ET AL.	
	Examiner FAHD A. OBEID	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/02/2006 and 11/30/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. **Claims 1-6** are pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the clause “and/or” is vague and indefinite. It is unclear whether the limitation refers to “providing conversion and selective extraction...etc” or “providing conversion or selective extraction...etc”. The clause “and/or” renders the claim vague and indefinite. Thus the limitation is not positively recited.

Claim 6 recites the clause “and/or” is vague and indefinite. It is unclear whether the limitation refers to “assembled and jointly analyzed by information brokers and customers” or “assembled and jointly analyzed by information brokers or customers”. The clause “and/or” renders the claim vague and indefinite. Thus the limitation is not positively recited.

Metes and Bounds of the invention is measured based on the language of the claims. The use of the clause “and/or” does not define boundaries of the invention; therefore it renders the claims vague and indefinite.

4. Claim 1 recites the limitation "the intranet/internet". There is insufficient antecedent basis for this limitation in the claim.
5. Claim 1 recites the limitation "the correlation". There is insufficient antecedent basis for this limitation in the claim.
6. Claim 1 recites the limitation "the corresponding matching". There is insufficient antecedent basis for this limitation in the claim.
7. Claim 2 recites the limitation "the performing". There is insufficient antecedent basis for this limitation in the claim.
8. Claim 3 is rendered indefinite by the use of the trademarked term "SAP" in the limitation "data submission in SAP-compatible format". MPEP § 608.01(v) states, "the examiner should hold the disclosure insufficient and reject on the ground of insufficient disclosure any claims based on the identification of the product merely by trademark or by the name used in trade." Furthermore, the term "SAP" is indefinite, because such a standard may be subject to change over time.
9. Claim 4 recites the limitation "the order processing". There is insufficient antecedent basis for this limitation in the claim.
10. Claim 5 recites the limitation "the information editing". There is insufficient antecedent basis for this limitation in the claim.
11. Claim 5 recites the limitation "the order processing". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jin (KR 2001-0107797) in view of Cronin (US 2001/0039505).

16. Regarding Claim 1: Jin discloses a method for producing storage media containing prerecorded structured information, comprising the steps of:

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- providing an order management accessible via the Intranet/Internet (fig.15),
- providing conversion and/or selective extraction of searched structured information from different data sources into a universal data model, wherein the correlation of the information with the corresponding matching order from the order management, and the provision of the storage media of any type, contain prerecorded structured information with unified format (abstract, figs. 9, 11, 13, 17, pgs.5, 7, 10).

Jin does not explicitly teach a tracking system.

However, Cronin does teach a tracking system (fig.3, ¶¶ 15, 16, 173).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Cronin's teachings in Jin's "method and apparatus for patent search services" enabled, for the advantage of providing flexible searching and sorting capabilities for databases (Cronin; ¶ 10). Also, to track the schedule and results of an invention (Cronin; ¶ 16).

17. Regarding Claim 2: Jin discloses the method as claimed in claim 1, wherein the order management and tracking system maps the workflows of a search department or of an information broker and enables the performing functions to perform order management, order processing, documentation and accounting (abstract, figs. 9, 11, 13, 17, pgs.5, 7, 10).

18. Regarding Claim 3: Jin discloses the method as claimed in claim 2, wherein the method provides for accounting by data transmission in SAP-compatible format (abstract, figs. 9, 11, 13, 17, pgs.5, 7, 10).

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19. Regarding Claim 4: Jin discloses the method as claimed in claim 2, wherein the order processing includes professional search and information editing (abstract, figs. 9, 11, 13, 17, pgs.5, 7, 10).

20. Regarding Claim 5: Jin discloses the method as claimed in claim 2, wherein the information editing is an integral component of the order processing by utilizing analysis functionalities by information brokers (abstract, figs. 9, 11, 13, 17, pgs.5, 7, 10).

21. Regarding Claim 6: Jin discloses the method as claimed in claim 5, wherein, as part of the information editing, unified structured information from professional and/or end user sources is imported, assembled and jointly analyzed by information brokers and/or customers (abstract, figs. 9, 11, 13, 17, pgs.5, 7, 10).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FAHD A. OBEID whose telephone number is (571)270-3324.

The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fahd A Obeid/
Examiner, Art Unit 3627
October 8, 2010